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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,203

05/11/2007

Hugo Vandaele

F-913 (31223.00143

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03/18/2009

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,203	Applicant(s) VANDAELE, HUGO	
	Examiner Terressa M. Boykin	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments with respect to claims 34-40 have been considered but are moot in view of the new ground(s) of rejection. Consequently, the Finality of the rejection has been withdrawn.

Rejection 35 U.S.C. 112, 1st Paragraph

Claims **34-40** are rejected under **35 U.S.C. 112**, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

After further consideration, applicants newly submitted claims filed in both 12-8-08 and 2-23-09 appear to contain new matter that was not in the original disclosure. Applicants have not clearly pointed out where such language exist within the original disclosure. For example, the term "suspended" has not been found either in the specification or the original claims. See also other newly added terms.

To expedite prosecution of the case it is advisable that applicants use terms which appear in the original disclosure.

Note MPEP 706.03

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under **35 U.S.C. 112**, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). See **MPEP § 2163.06 - § 2163.07(b)** for a discussion of the relationship of new matter to **35 U.S.C. 112**, first paragraph. New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See **MPEP § 608.04 to § 608.04(c)**. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) and **MPEP § 2163.05** for guidance in determining whether the addition of specific percentages or compounds after a broader original disclosure constitutes new matter.

Since the issue of new matter has not been settled, the previous rejection is being

continued.

Claim Rejections - 35 USC § 112

Claims 34-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for those particular steps as disclosed on pages 8-9, does not reasonably provide enablement for any type of recover of the slurry of polymer particles from a polymerization reactor as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make any use the invention commensurate in scope with these claims.

Case law holds that applicant's specification must be "commensurately enabling [regarding the scope of the claims]." See *Ex Parte Kung*, 17 USPQ2d 1545, 1547 (Bd. Pat. Appl. Inter. 1990). Otherwise **undue experimentation** would be involved in determining how to practice and use applicant's invention. The test for undue experimentation as to whether or not all compounds within the scope of claims 34-40 can be used as claimed and whether claims 34-40 meet the test is stated in *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. Appl. Inter. 1986) and *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Upon applying this test to claims 34-40, it is believed that undue experimentation **would** be required because:

(a) *The quantity of experimentation necessary* is **great** since claims 34-40 read on any type of recovery such as that which is claimed while not necessarily applying the particular steps as noted on pages 8-9 of the specification.

(c) There is an **absence** of *working examples* concerning the steps comprising any type of recovery other than those as disclosed on pages 8-9 of the specification.

It is noted that although the CCPA has criticized the use of the characterization "too broad" or "undue breadth"....however, an application whose claim(s) are of a breadth which are not adequately supported by its specification is in violation of 35 USC 112, first paragraph. *In re Borkowski et al.*, (CCPA 1970) 424 F2d 904; *In re Wakefield*, (CCPA 1970) 422 F2d 897; *In re Hammack*, (CCPA 197

Art Unit: 1796

In light of the above factors, it is seen that undue experimentation would be necessary to make and use the invention of claims 34-40.

Proper Abstract missing

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Abstract

Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. The printer will no longer accept Abstracts that are more than 25 lines, regardless of the number of words. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Art Unit: 1796

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terressa M. Boykin whose telephone number is 571 272-1069. The Examiner can normally be reached Monday- Friday 9:30-6:00 (work at home).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272-1078.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Terressa M. Boykin/

Application/Control Number: 10/589,203

Page 6

Art Unit: 1796

Primary Examiner, Art Unit 1796